

**II. Specification**

The Office has maintained that the amendment filed April 10, 2000 is objected to under 35 U.S.C. § 132 because it introduces new matter into the disclosure. See Office Action dated October 4, 2001, at page 2. According to the Office, "the added material which is not supported by the original disclosure is as follows: -CO-A-CO-(CH<sub>2</sub>CH<sub>2</sub>)<sub>n</sub>-OH." *Id.*, lines 4-5 under "Specification."

Applicant respectfully points out that the above cited Office Action and the Office Action dated April 3, 2001 mistakenly refer back to an amendment filed on April 10, 2000, which does not exist. Rather, the only amendment Applicant has of record is the Preliminary Amendment filed September 13, 1999. As such, clarification is respectfully requested.

Furthermore, the Office states "[t]he Examiner acknowledges Applicant's arguments regarding this formula, but the Examiner respectfully points out that this formula is not explicitly shown in the priority document. . . the formula continues to be objected to as added material which is not supported by the original disclosure." See Office Action dated October 4, 2001, at page 4. However, Applicant's Response dated August 31, 2001 and the Preliminary Amendment filed September 13, 1999 did not add "-CO-A-CO-(CH<sub>2</sub>CH<sub>2</sub>)<sub>n</sub>-OH" to the instant specification or any of the claims. Thus, Applicants submit that the objection is improper and shown be withdrawn for this reason alone.

Moreover, if the Office is referring to the Preliminary Amendment filed September 13, 1999, which amends the instant application to "delete -CO-A-CO-O-(CH<sub>2</sub>CH<sub>2</sub>)<sub>n</sub>-OH and replace it with -- -CO-A-CO-O-(CH<sub>2</sub>CH<sub>2</sub>O)<sub>n</sub>-OH -- [at page 5, line 22], Applicants

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maintain that this amendment to correct a typographical error is not new matter for the reasons cited in the Response dated August 31, 2001, at page 2, line 17 through page 3, line 6. In addition, as the Office is aware, the M.P.E.P. provides guidance in this situation: "An amendment to correct an obvious error does not constitute new matter where one skilled in the art would not only recognize the existence of error in the specification, but also the appropriate correction." M.P.E.P. § 2163.07(II), citing *In re Oda*, 443 F.2d 1200, 170 USPQ 260 (CCPA 1971). In the instant case, Applicant respectfully submits that in view of the entire disclosure, Applicant has done no more than make an obvious correction to an obvious error.

In view of the foregoing, Applicants respectfully request reconsideration and withdrawal of this objection.

**III. Rejection under 35 U.S.C. § 102(e)**

The Office has maintained the rejection of claims 18-29, 35, 36, and 39 under 35 U.S.C. §102(e) over Dupuis et al. (U.S. Patent No. 6,031,043) ("Dupuis") for the reasons set forth in the Office Action dated October 4, 2001.

Specifically, the Office admits that Dupuis does not "disclose initial and final viscosities, as the instant invention does," but that "a composition comprising the same constituents must exhibit the same properties." Office Action dated October 4, 2001 at page 3, lines 7-10. Further, the Office asserts that the "properties of a composition are the direct result of the inherent properties of the constituents which comprise a composition." *Id.* at lines 10-11. Applicant respectfully traverses this rejection for the reasons of record, as well as for the additional reasons discussed below.

First, as the Office is aware, in order to anticipate a claim, a reference must contain all elements of the claim. See *Hybritech v. Monoclonal Antibodies, Inc.*, 802 F.2d 1367, 1379, 231 U.S.P.Q. 81, 90 (Fed. Cir. 1986). Further, as according to M.P.E.P. § 2131, "The identical invention must be shown in as complete detail as is contained in the . . . claim." *Id.* (emphasis added). For example, claim 18 recites, in relevant part, "an initial viscosity  $V_0$  ranging from 3000 to 50,000 Pa.s, wherein said initial viscosity  $V_0$  is stable up to a shear strain  $C_1$ , a viscosity  $V_2$  after shear at a strain  $C_2$ , wherein a ratio of  $V_0/V_2$  is greater than or equal to 1000, and a difference of  $C_2-C_1$  is less than or equal to 100 Pa." As such, without the recitation of the viscosity limitations of claim 18, Dupuis fails to identically disclose the instant invention and fails to disclose all of the claim elements.

Second, the present rejection is flawed for at least the reasons that (1) the appropriate legal standards for establishing inherency have not been applied, and (2) no evidence has been cited to show that the cited reference necessarily contains all the claimed features of the present invention.

A. Legal Standards Establishing Inherency

In order to establish inherency, the Office has the burden of showing more than the mere possibility that the cited reference is capable of performing the claimed function. In fact, "[i]nherency... may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient." *Continental Can Co. USA, Inc. v. Monsanto Co.*, 948 F.2d 1264, 1268-69, 20 U.S.P.Q.2d 746, 1749 (Fed. Cir. 1991) (internal citations omitted) (emphasis added). Likewise, "[t]he fact that a certain result or characteristic may occur or be present in the

prior art is not sufficient to establish the inherency of that result or characteristic."

MPEP §2112 (emphasis added).

Furthermore, to support an anticipation rejection based on inherency, rather than showing mere possibility, the Examiner must provide factual and technical grounds establishing that the feature necessarily flows from the teaching of the prior art. See *Ex parte Levy*, 17 U.S.P.Q.2d 1461, 1464 (Bd. Pat. App. & Int.. 1990) 1990); see also *In re Oelrich*, 666 F.2d 578, 581, 212 U.S.P.Q. 323, 326 (C.C.P.A. 1981) (holding that inherency must flow as a necessary conclusion from the prior art, not simply a possible one).

Here, the Office has not provided factual and technical grounds establishing that the feature (i.e., the viscosity) necessarily flows from the teaching of the cited reference. Instead, the Office has merely made unsupported assertions (e.g., "a composition comprising the same constituents must exhibit the same properties"). Accordingly, since the Office has not complied with the legal requirements necessary for making the required showing of inherency, the rejection should be withdrawn.

B. There is No Evidence that Dupuis Performs the Function Specified in the Claims

As noted above, the Office has failed to make the required showing that Dupuis necessarily includes the viscosity limitations specified in the claims. Further, Applicants respectfully assert that this failure cannot be overcome based on the disclosure of

Dupuis. Rather, Dupuis lacks any teaching, much less any suggestion or even a possibility, that it includes all the necessary claimed features of the present invention.

That is, there are no factual or technical grounds to establish that a gel having the

rheological profile of the present invention necessarily flows from the teachings of Dupuis.

It is argued in the Office Action that "properties of a composition are the direct result of the inherent properties of the constituents which comprise a composition." Office Action at page 3, lines 10-11. This argument, however, relies at best on a mere possibility, based on Dupuis, and not a necessary result of that reference. However, as discussed above, a mere possibility is insufficient to establish inherency. Rather, the feature must necessarily flow from the teaching of the prior art. Clearly, no showing has been made that the claimed viscosity limitations necessarily flow from Dupuis.

Accordingly, since the Office has not cited evidence that the claimed viscosities necessarily flow from Dupuis, inherency has not been established. Moreover, since all of the claimed features of the present invention are not taught by the cited reference, the present claims 18-29, 35, 36, and 39 are not anticipated by Dupuis.

In view of the above remarks taken independently, Applicant respectfully submits that the rejection under 35 U.S.C. § 102(e) is improper and should be withdrawn.

#### **IV. Rejection under 35 U.S.C. § 103**

The Office has maintained the rejection of claims 18-53 under 35 U.S.C. §103(a) over O'Neill (U.S. Patent No. 4,300,580) in view of Disselbeck et al. (U.S. Patent No. 5,804,025) further in view of Adams et al. (WO 95/00105), and Dupuis (U.S. Patent No. 5,830,438) for the reasons set forth in the Office Action dated October 4, 2001.

Applicant respectfully traverses this rejection for the reasons of record, as well as for the additional reasons discussed below.

First, combining prior art references without evidence of such a suggestion or motivation simply takes the inventor's specification as a blueprint for piecing together the prior art to defeat patentability, i.e., the essence of hindsight. See, e.g., *In re Dembiczak*, 50 USPQ.2d 1614 (Fed. Cir. 1999). Accordingly, the Federal Circuit placed the burden on the Office to present "clear and particular" evidence showing motivation to combine. *Dembiczak*, 50 USPQ.2d at 1617.

To meet this burden of specificity, the Examiner must provide particular findings as to why the skilled artisan, with no knowledge of the claimed invention, would have selected these components for combination in the manner claimed. *In re Kotzab*, 217 F.3d 1365, 1371 (Fed. Cir. 2000). The Examiner must satisfy this burden by showing some objective teaching in the prior art that would lead one of ordinary skill in the art to combine the prior art in the manner proposed by the Examiner. *In re Fritch*, 972 F.2d 1260, 1265 (Fed. Cir. 1992)(emphasis added).

Secondly, "[t]he mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination." M.P.E.P. § 2143.01, citing *In re Mills*, 916 F.2d 680, 16 U.S.P.Q.2d 1430 (Fed. Cir. 1990).

Nonetheless, the Office states that "[w]hile Disselbeck is not directed to cosmetic compositions . . . Disslebeck was used only to teach the possible mole percents of the 1,4 and 1,3-phenylene groups (aromatic radical substituents) that **could be** substituted into the polyester." Office Action dated October 4, 2001, at page 3, lines 18-21.

However, as shown above, even though references **can be** combined, this does not, by itself, establish proper grounds for a prima facie case of obviousness. That is, even

though Disselbeck may teach "possible mole percents," obviousness under § 103 of 35 U.S.C. must be established with motivation or with a suggestion from the references that there is desirability for the combination.

The Office adds that "one in the hair fixative art would look to Disselbeck because Disselbeck teaches the same water dispersible terephthalic copolyester oligomers comprising dicarboxylate repeating units as the instant invention with the same aromatic radical substituent." Office Action dated October 4, 2001, at page 3, line 21 - page 4, line 2. Applicant respectfully disagrees. As previously discussed in the Response dated August 31, 2001, at pages 10, lines 3-5, Disselbeck does not suggest or disclose compounds that are useful for topical compositions. Particularly, Disselbeck is directed to high frequency welding. Thus, it would be implausible for one of ordinary skill in the "hair care" art to look to Disselbeck for any guidance, as Disselbeck is non-analogous art. Second, the Office has not provided any "clear and particular" evidence that establishes the motivation to combine Disselbeck with a reference in the "hair care" art. As such, the rejection is improper for this reason alone and should be withdrawn.

However, the Office argues that Disselbeck is not relied upon for its teachings of the terephthalic copolyester, but for its teaching of the percent of the aromatic radical substituents that **can be** added to the copolyester," for which O'Neill is deficient. Office Action dated October 4, 2001, at page 4, lines 2-5. According to the Office, "Disselbeck was used to show that the copolyester of O'Neill **could have** the same mole percent of the aromatic radical substituent of the instant invention." *Id.* at lines 7-8. As discussed *supra*, however, even though references **can be** combined, this does not, by itself,

establish motivation to combine the teachings of those references. Rather, there must be "clear and particular" evidence showing motivation to combine the references.

Otherwise, the rejection is based on hindsight, which is improper. Accordingly, Applicants respectfully submit that the Office has failed to present any "clear and particular" evidence that demonstrates that one of ordinary skill in the art would have been motivated to combine Disselbeck and O'Neil to achieve the present invention. Particularly, as discussed *supra*, Disselbeck is non-analogous art. Thus, as the Office has failed to demonstrate a prima facie case of obviousness, the rejection should be withdrawn.


#### **Conclusion**

In view of the foregoing remarks, Applicant submits that this claimed invention is not anticipated nor obvious in view of the prior art reference cited against this application. Applicant therefore requests the Office's reconsideration and reexamination of the application, and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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